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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,613	12/16/2003	Shigeo Fukuda	FUKU3001/EM	2775

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/735,613

Applicant(s)

FUKUDA, SHIGEO

Examiner

Kevin M. Bernatz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. Cancellation of claims 6 - 10 and addition of new claims 14 - 16, filed on December 27, 2006, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Request for Continued Examination

3. A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 27, 2006 has been entered. An action on the RCE follows.

Claim Rejections - 35 USC § 103

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai et al. (JP 11-103915 A) in view of Takeshita et al. (U.S. Patent No. 4,981,532) and Okinaka et al. (U.S. Patent No. 4,067,783). See provided Machine Translation of JP '915 A.

Sakurai et al. and Takeshita et al. are relied upon as described in Paragraph No. 6 of the Office Action mailed on May 2, 2006.

Neither Sakurai et al. nor Takeshita et al. disclose a plated layer (*i.e. a metal or metal containing layer capable of being deposited from a plating bath*) formed on each of said unit permanent magnets.

However, the Examiner notes that Sakurai et al. does teach that at least some of the metal beads can be solid magnetic bodies (*Paragraph 0008*) and the Examiner deems that it would have been obvious to one of ordinary skill in the art that all of the beads could be formed from solid magnetic bodies as a matter of obvious design choice. Furthermore, Okinaka et al. teach that it is known in the art to plate bodies used for jewelry with gold, since gold plating enhances the aesthetic appeal and corrosion resistance of the jewelry (*col. 1, lines 5 – 39*).

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the device of Sakurai et al. in view of Takeshita et al. to use magnetic bodies including a plated layer as taught by Okinaka et al., since such a plated layer can enhance the aesthetic appeal and corrosion resistance of the jewelry.

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5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai et al. in view of Takeshita et al. and Okinaka et al. as applied above, and further in view of the combined teachings of Hart (U.S. Patent No. 5,195,335), Yellen (U.S. Patent No. 6,427,486 B1), Lu (U.S. Patent App. No. 2004/0111005 A1) and Jacobson (U.S. Patent No. 6,634,067 B2).

Sakurai et al., Takeshita et al. and Okinaka et al. are relied upon as described above.

None of the above disclose the plurality of unit permanent magnets possessing a shape meeting the claimed limitations.

However, the Examiner deems that spherical magnetic jewelry beads and cylindrical, flat or disk shaped magnetic jewelry beads are known equivalents in field of jewelry beads useable as magnetic bodies, as taught by the combined teachings of Hart (*col. 1, lines 19 – 22 and col. 2, lines 16 – 33*), Yellen (*Figures and col. 1, line 8 bridging col. 2, line 58*), Lu (*Figures and Paragraphs 0001 – 0008 and 0019*), and Jacobson (*col. 6, lines 35 – 45*). Specifically, the Examiner notes that the prior art of record clearly demonstrates that one of ordinary skill in the art would have recognized that jewelry, whether magnetic or non-magnetic, can be formed in a wide variety of shapes depending on the desired aesthetic appeal. In all cases, the magnetic jewelry body would continue to function as intended – an aesthetic piece of jewelry that is magnetically attracted to the adjacent magnetic body.

Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. In the instant case, forming magnetic bodies as spheres

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and cylinders, flat-shapes or disks are equivalents in the field of shapes useable for magnetic bodies in jewelry. *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* 85 USPQ 328 (USSC 1950). Furthermore, the Examiner notes that the exact choice of shape is a matter of obvious design choice.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai et al. in view of Takeshita et al. and Okinaka et al. as applied above, and further in view of Hoffman (U.S. Patent No. 4,517,217).

Sakurai et al., Takeshita et al. and Okinaka et al. are relied upon as described above.

None of the above disclose a coating layer meeting Applicants' claimed limitations.

However, Hoffman teaches a coating meeting Applicants' claimed material limitations for deposition over gold plated jewelry in order to permit the use of thinner gold plating without detracting from the quality, durability or appearance of the jewelry (*Abstract and entire disclosure*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Sakurai et al. in view of Takeshita et al. and Okinaka et al. to utilize a coating layer meeting Applicants' claimed limitations as taught by Hoffman, since such a coating layer permits the use of thinner gold plating without detracting from the quality, durability or appearance of the jewelry.

Response to Arguments

7. The rejection of claims 6 - 10 under 35 U.S.C § 103(a) – Sakurai et al. in view of various references

The above noted rejection has been withdrawn because applicant(s) have cancelled the above identified claims.

8. The rejection of claims 14 - 16 under 35 U.S.C § 103(a) – Sakurai et al. in view of various references

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Delaney (U.S. Patent App. No. 2005/0148809 A1) discloses a substantially identical invention as disclosed by Applicants (*magnetic bodies for use as therapeutic jewelry without additional linking means*) (*see entire disclosure*). Hayakawa (U.S. Patent No. 5,535,603) disclose magnetic jewelry that is linked together via magnetic attraction (*entire disclosure*). GB 2287884 A disclose a magnetic necklace comprising "all or some of a plurality of ornaments of permanent magnets", but discloses forming them in the shape of polyhedrons (*Figures and entire disclosure*). GB

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2285222 A disclose a magnetic necklace comprising magnetic beads, wherein the magnets are coated for aesthetic appeal (*Figures and entire disclosure*).

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
February 27, 2007


Kevin M. Bernatz, PhD
Primary Examiner